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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: William P. Apps

EXAMINER: Castellano, S.

SERIAL NO.: 09/780,073

GROUP ART UNIT: 3727

FILED: February 9, 2001

FOR: NESTABLE CAN TRAY WITH CONTOURED WALL STRUCTURE

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SUBSTITUTE APPEAL BRIEF

Dear Sir:

Appellant files this Substitute Appeal Brief pursuant to the Notice of Appeal filed May 6, 2003 and the Notification of Noncompliance mailed August 19, 2003.

Real Party in Interest

The real party in interest is Rehrig Pacific Company, the Assignee of the entire right and interest in this application by assignment in its parent application recorded on March 15, 1999, at Reel 9821, Frame 0011.

Related Appeals and Interferences

There are no related appeals and interferences.

Status of the Claims

All of the pending claims, claims 1-28, are rejected and appealed.

CERTIFICATE OF MAIL

I hereby certify that the enclosed Appeal Brief (in triplicate) and fee are being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 22, 2003.


Konstantine J. Diamond

Status of Amendments

Appellant previously filed an “Amendment with Appeal” with the original Appeal Brief, as provided for in MPEP §1207, in order to remove issues from appeal and avoid a remand by the Board to consider such issues. This amendment sought to correct a few minor antecedent basis rejections by the Examiner under 35 USC §112 to claims 13 and 22.

Claim 13 recites “an uppermost edge of the band side detail” and later recites “the upper edge of the band side detail” as shown below (underline added):

13. A low depth nestable tray for containers, having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band is contoured downwardly along the side portions to form a band side detail that directly connects to the floor surface at the side portions of said tray, and wherein an uppermost edge of the band side detail is an uppermost surface of the wall structure at the band side detail and wherein the upper edge of the band side detail at each band side detail is below an uppermost surface of the side and end portions of the band.

The Examiner rejected claim 13:

Claim 13 recites the limitation “the upper edge” of the band side detail in the second to last line. There is insufficient antecedent basis for this limitation in the claim because it can’t be determined if “the upper edge” refers to the “uppermost edge” previously recited in the claim. The claim is ambiguous since the upper edge could refer to any upper edge and upper edge which is not an uppermost edge or an uppermost edge.¹

To remove this issue from the Appeal, Appellant filed an Amendment with Appeal seeking to amend “the upper edge” to say “the uppermost edge.” The Examiner did not enter this amendment, saying it “complicates the issues for appeal.” This Amendment should have been entered because Appellant was only correcting the obvious minor error that was already noted by the Examiner. However, even without this proposed amendment to the claim, the claim is not

¹ Final Rejection Mailed April 2, 2003, page 2.

indefinite, because the scope of the claim would be “reasonably ascertainable by those skilled in the art.” (See Argument section VIII, below).

Appellant submits herewith a Second Amendment with Appeal amending only claim 22 to address the §112 rejection by the Examiner. A copy of this “Second Amendment with Appeal” is attached to this brief after the Claim Appendix as Exhibit A. However, the Claim Appendix will not reflect the “Second Amendment with Appeal” until it is officially entered.

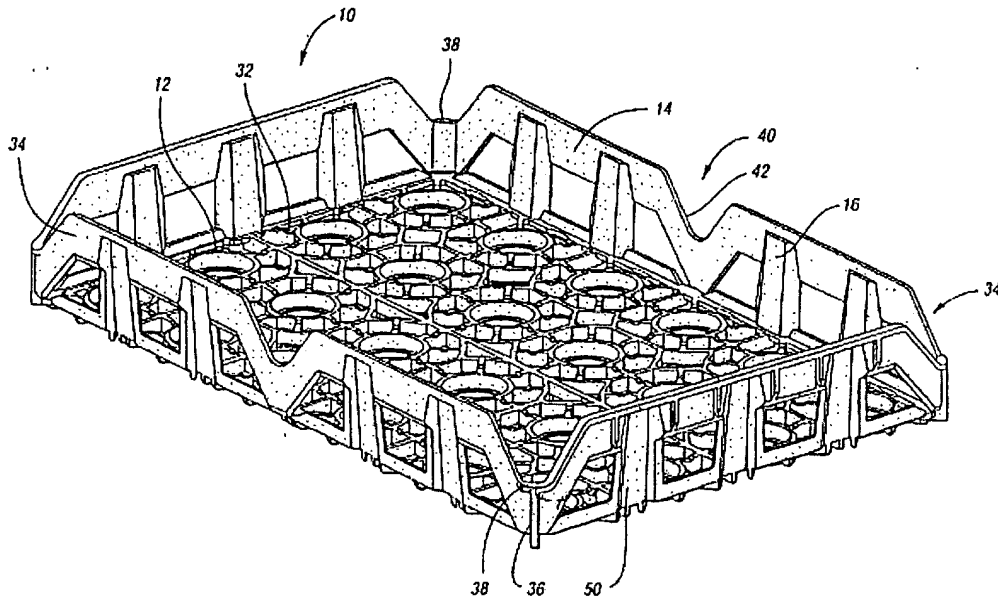
Summary of the Invention

The present invention relates to a low depth, nestable tray for transporting and storing beverage containers, such as twelve ounce aluminum beverage cans. Plastic trays with side walls that are lower than the height of the stored containers are referred to as “low depth trays.” Since the containers (e.g. the beverage cans) placed in these trays would extend above the side walls, the containers in the lower tray support the weight of the trays stacked on top of them. When empty, many can trays are configured to be nestable within one another to reduce the amount of space they take up during transport. Generally, the known trays comprise a floor, a band spaced from the floor and a plurality of columns interconnecting the floor and the band. In general, the columns are arranged at the corners and along the end walls and side walls of the trays. (page 1, line 14 to page 2, line 3)

Often, the beverage cans are bundled together with a secondary packaging, such as an overwrap or paperboard wrap. The column and band construction of prior trays interferes with the handling of the cans that are bundled together and damages the secondary packaging. The corners and the longer side walls present areas in which interference with secondary packaging has been experienced. (page 2, lines 5-9)

In the present invention, the band is angled downwardly from the horizontal or contoured in certain areas to contact the floor itself, thereby eliminating a column. (page 6, lines 27-29). This reduces interference with the secondary packaging of the beverage cans. As can be seen in the preferred embodiment shown in Figure 1, the band 14 is contoured downward at the corners, thereby eliminating the corner columns. The band 14 is also contoured down to the floor at least once along each side wall. The elimination of the corner columns and a column on each side wall significantly reduces any interference or damage to the secondary packaging around

multi-packs of beverage cans. (page 7, line 29 to page 8, line 2) Figure 1 of Appellant's application is reproduced below.



Appellant's Figure 1

This feature is claimed in each of the independent claims currently pending. Claim 1 recites, "said band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of said tray . . .". Claim 6 recites, "said band is contoured downwardly along the side portions to form a band central portion that directly connects the floor structure at the side portions of said tray." Claim 13 recites, "said band is contoured downwardly along the side portions to form a band side detail that directly connects to the floor structure at the side portions of said tray . . .". Claim 22 recites, "the band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of the tray . . .".

Issues

I) The final rejection of claims 6, 8, 9 and 12 under 35 U.S.C. §102 as being anticipated by Carroll (US Des. 239,213) is improper.

II) The final rejection of claims 6-18 and 21-26 under 35 U.S.C. §102 as being anticipated by Apps '925 (U.S. Patent No. 5,323,925) is improper.

III) The final rejection of claims 1-10, 12-15, 17-19 and 21-28 under 35 U.S.C. §103(a) as obvious over Carroll is improper

IV) The final rejection of claim 8 under 35 U.S.C. §103(a) as obvious over Apps '925 in view of David (U.S. Patent No. 4,079,077) is improper.

V) The final rejection of claims 11, 16 and 20 under 35 U.S.C. §103(a) as obvious over Carroll in view of Apps '925 is improper.

VI) The final rejection of claims 1-28 for nonstatutory double-patenting over U.S. Des. 404,204 is improper.

VII) The final rejection of claims 1-28 for nonstatutory double-patenting over U.S. Patent No. 6,186,328 is improper.

VIII) Claims 13-18 and 21-28 are rejected under 35 U.S.C. §112 as indefinite because of antecedent basis issues in claims 13 and 22. The §112 issue in claim 22 is mooted by the "Second Amendment with Appeal," which is filed with this brief (copy at Exhibit A). The §112 rejection of claim 13 is improper.

Grouping of Claims

The rejections of claims 1-28 are contested. Claims 1-28 do not stand or fall together.

For purposes of this appeal only and based upon the underlying rejections being appealed, Appellant groups the claims as follows:

I) For the anticipation rejection over Carroll:

Group A) Claims 6, 8, 9 and 12 stand or fall together.

II) For the anticipation rejection over Apps '925, claims 6-18 and 21-26 do not stand or fall together²:

Group B) Claims 6, 8, 9, 11 and 12 stand or fall together, but do not stand or fall with the other Groups C-G.

Group C) Claims 13, 16, 18 and 21 stand or fall together, but do not stand or fall with the other Groups B or D-G.

² For simplicity, Appellant's original brief simply omitted reference to claims dependent from the claims that are independently patentable. In response to the Examiner's objection, Appellant has returned them to the groupings.

Group D) Claims 22-26 stand or fall together, but do not stand or fall with the other Groups B-C or E-G.

Group E) Claim 7 does not stand or fall with the other Groups B-D or F-G

Group F) Claims 14 and 15 stand or fall together, but do not stand or fall with the other Groups B-E or G.

Group G) Claims 10 and 17 do not stand or fall with the other Groups B-F.

III) For the obviousness rejection over Carroll:

Group H) Claims 1-10, 12-15, 17-19 and 21-28 stand or fall together.

IV) For the obviousness rejection over Apps '925 in view of David:

Group I) Claim 8 is the only claim rejected.

V) For the obviousness rejection over Carroll in view of Apps '925:

Group J) Claims 11, 16 and 20 stand or fall together.

VI) For the non-statutory double-patenting rejection over U.S. Des. 404,204:

Group K) Claims 1-28 stand or fall together for this rejection.

VII) For the nonstatutory double-patenting rejection over U.S. Patent No. 6,186,328:

Group L) Claims 1-28 stand or fall together for this rejection.

Argument

I. Anticipation by Carroll

The Examiner has rejected claims 6, 8, 9 and 12 as anticipated by Carroll (US Des 239,213).

Group A) Claims 6, 8, 9 and 12

Claim 6 recites that the columns are generally perpendicular to the floor and that parallel portions of the band are generally parallel to the floor. Carroll does not disclose columns or columns that are generally perpendicular to the floor or a band with parallel portions that are generally parallel to the floor. For "columns," the Examiner points to portions of the outer zig-zag which attach the inner zig-zag structure to the floor. (pages 2-3 of April 2, 2003 Office Action). However, the

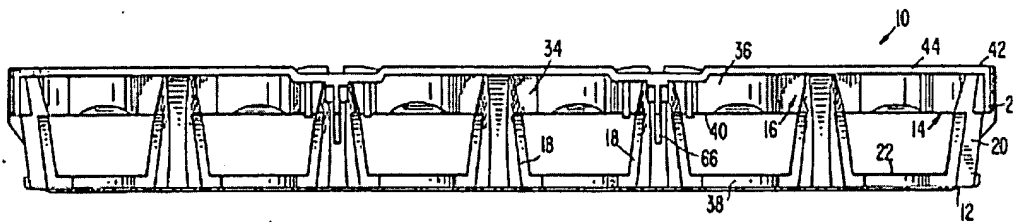
Examiner does not even allege that these portions of the outer zig-zag are “generally perpendicular to the floor” as require by claim 6. In fact, those portions are not “generally perpendicular” because they are a zig-zag and extend at an acute angle relative to the floor. Therefore, claims 6, 8, 9 and 12 are not anticipated by Carroll.

II. Anticipation by Apps '925

The Examiner has rejected claims 6-18 and 21-26 under 35 U.S.C. §102 as being anticipated by Apps '925 (also the inventor of this application) (U.S. Patent No. 5,323,925).

Groups B, C and D) Independent Claims 6, 13 and 22 (and claims dependent therefrom)

Apps '925 discloses a tray comprising "an enclosing rail 16 maintained in vertically spaced relation with respect to the floor by means of a plurality of columns 18 disposed in longitudinally spaced relation about the periphery of the apparatus" (column 5, lines 25-28; Fig. 5, reproduced below). Apps '925 further discloses that "support[s] posts 20 located at each of the four corners of the tray serve to maintain the rail 16 in spaced relation to the floor 12 and provide additional corner support for the tray 10" (column 5, lines 29-32). This is generally the tray described in Appellant's "BACKGROUND OF THE INVENTION" section of the application.



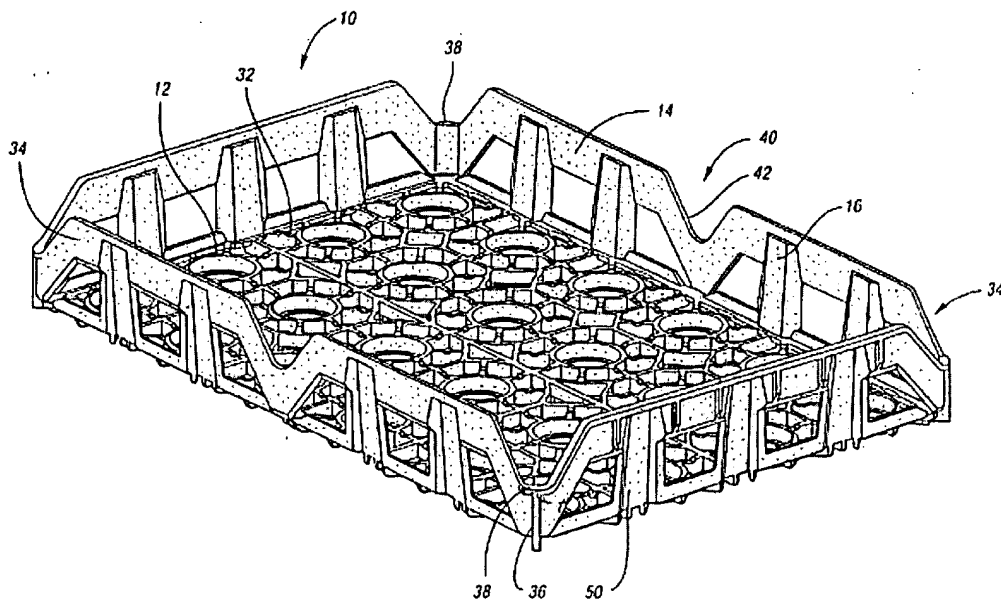
Apps '925, Figure 5

As can be seen in Figure 5 of Apps '925 above, the rail 16 of Apps '925 is not "contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of said tray" as required by claim 22. Nor is the rail 16 of Apps '925 "contoured downwardly along the side portions . . . to form a band central portion (side detail) that directly connects to the floor . . . at the side portions of said tray" as required by claims 6 and 13.

The Examiner has referred to the rail 16 and corner post 20 of Apps '925 collectively as "the band" to try to meet these requirements of the rejected claims 6,

13 and 22. This is incorrect for two reasons. First, although the Examiner is permitted to interpret the claims broadly, the Examiner's interpretation must still be reasonable and must be the "plain meaning" unless the applicant has provided a clear definition in the specification.³ It is unreasonable to include the post 20 as part of the normal definition of "band" as "a thin strip of flexible material used to encircle and bind one object or to hold a number of objects together."⁴ The post 20 is not part of the "thin strip," not part of the rail 16 and therefore not part of "the band." Second, even if it *were* proper to take the rail 16 in combination with the post 20 to meet the term "band," this rail/column combination is not "contoured downwardly" as required by claims 6, 13 and 22. Although the post 20 extends to the floor from the rail 16, the rail/post combination is not "contoured downwardly" because the rail 16 remains level and is not "curved downwardly." The rail/post combination is at best a band (the rail 16) with a protrusion or extension (the post 20).

This contrast can be seen by comparing Figure 1 of the present application (reproduced below) to Figure 5 of Apps '925 (reproduced above).



Appellant's Figure 1

³ MPEP 2111.01; *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

⁴ The American Heritage Dictionary, Second College Edition

In Figure 1 of the present application, the band 14 is contoured downwardly at the corner, in other words the "thin strip" is "curved" downwardly to the floor at the corner. In contrast, in Apps '925, the rail is not curved or contoured at all, rather, a post simply projects from the rail at the corner. The Examiner's interpretation of "contoured" and/or "band" is unreasonable.

Not only is the Examiner's current interpretation of these terms unreasonable and contrary to the "ordinary definition," it contradicts his initial conclusion in this application. After this application was filed, the Examiner responded with a Notice of Allowability (mailed May 7, 2001) and a signed list of references that included the Apps '925 patent. This affirms the reasonableness of Appellant's interpretation of the claims. The Examiner has not attempted to explain his reasons for changing his interpretation of the claims. For this reason, all of the claims 6-18 and 21-26 are patentable.

Group B) is Patentable Independently of Groups C) and D)

Claims 13 and 22 do not specify that the band includes parallel portions generally parallel to the floor structure and is contoured downwardly along the side portions between the parallel portions to form a band central portion that directly connects to the floor structure, as required by claim 6. Whatever the Examiner is calling the "band" in Apps '925, it does not "contour downwardly" between portions parallel to the floor structure. Therefore, claim 6 is also patentable independently of claims 13 and 22. *not argument*

Groups B) and C) are Patentable Independently of Group D)

Claim 22 does not specify that the band is "contoured downwardly along the side portions . . . to form a band central portion (side detail) that directly connects to the floor . . . at the side portions of said tray" as required by claims 6 and 13. Since this feature is not shown in Apps '925, claims 6 and 13 are also patentable independently of claim 22. *not argument*

Group D) is Patentable Independently of Groups B) and C)

Claims 6 and 13 do not require that the band is "contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of said tray" as required by claim 22. Since this feature is also not shown in Apps '925, claim 22 is patentable independently of claims 6 and 13. Further, claims 6 and 13 do not specify that the "top surface of the band at the band corner portion is the uppermost surface of the tray at the band corner portion to contact and support a like *not argument*

tray nested thereabove,” as required by claim 22. Since this feature is also not shown in Apps ‘925, claim 22 is also independently patentable for this additional reason as well. In Apps ‘925, the surface that contacts and supports a like tray nested thereabove is not the uppermost surface of the tray at the corner. *not argument*

Group C) is Patentable Independently of Groups B) and D)

Claims 6 and 22 do not specify:

an uppermost edge of the band side detail is an uppermost surface of the wall structure at the band side detail and wherein the upper edge of the band side detail at each band side detail is below an uppermost surface of the side and end portions of the band

as required by claim 13. Since this features is also not shown in Apps ‘925, claim 13 is also patentable independently of claims 6 and 22. As can be seen in Apps ‘925, the upper edge of the rail is the same height throughout the entire periphery of the crate. Therefore, claim 13 is not anticipated by Apps ‘925.

Group E) Claim 7

Claim 7 depends from claim 6 and further specifies that the band central portion has a top edge to receive a mating bottom edge of a band central portion of a like tray nested thereabove. In order to meet the terms of claim 6, the Examiner has called the rail 16 together with the columns the “band central portion.” Thus, to try to apply claim 7 to the Examiner’s interpretation of Apps ‘925, the top edge of the rail 16 of one tray must mate with a bottom edge of a column of an above tray. However, as is apparent from Figure 14 of Apps ‘925, the “bottom edge” of the column of one tray does not mate with a “top edge” of the rail 16 of a like tray below it. Rather, because the rail 16 does not contour downwardly, the column and part of the rail 16 of the upper tray *nests within* the rail 16 at the column, rather than mating with a top edge of the band, as claimed. Therefore, claim 7 is patentable and patentable independently of claim 6.

The claims of Groups B-D) and F-G) do not specify that the band central portion has a top edge to receive a mating bottom edge of a band central portion of a like tray nested thereabove. Since this feature is not shown in Apps ‘925 under the

Examiner's interpretation, claim 7 is patentable independently of the claims of Groups B-D) and F-G).

Group F) Claim 14

Claim 14 further specifies that "one said side portion of said band is contoured downwardly and one said end portion is contoured downwardly so as to converge together" to form a band corner portion. Even if the Examiner's rail/post combination were taken to be the claimed "band," there is no side portion of the rail 16 that is "contoured downwardly" or an "end portion" that is "contoured downwardly so as to converge together" as claimed in claim 14. Therefore, claim 14 is patentable independently of claims 6 and 13.

The claims of Groups B-E) and G) do not specify that "one said side portion of said band is contoured downwardly and one said end portion is contoured downwardly so as to converge together" to form a band corner portion. Since this feature is also not shown in Apps '925 under the Examiner's interpretation, claim 14 is patentable independently of the claims of Groups B-E) and G).

Group G) Claims 10 and 17

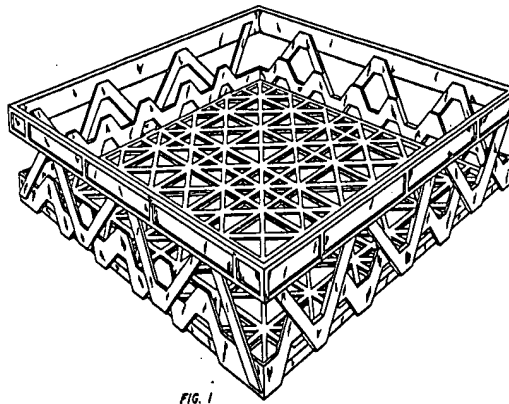
Claims 10 and 17 each specify a rib on an exterior surface of at least one band corner portion, and a platform at an upper edge of a corresponding band corner portion for supporting the rib of an adjacent above-nested tray. The ribs 21 of Apps '925 are not supported on a "platform at an upper edge of a corresponding band corner portion" as claimed. Rather, the ribs 21 of Apps '925 rest on shoulders that are spaced below the upper edge of the rail 16, not at "an upper edge of a corresponding band corner portion." Therefore, claims 10 and 17 are properly allowable and patentable independently of claims 6 and 13, from which they depend.

The claims of Groups B-F) do not specify a rib on an exterior surface of at least one band corner portion, and a platform at an upper edge of a corresponding band corner portion for supporting the rib of an adjacent above-nested tray. Since this feature is also not shown in Apps '925, claims 10 and 17 are patentable independently of the claims of Groups B-F).

III. Obviousness over Carroll

Group H) Claims 1-10, 12-15, 17-19 and 21-28

The Examiner has rejected claims 1-10, 12-15, 17-19 and 21-28 as obvious over Carroll. The Examiner's argument is that, taking the Carroll design, it would have been obvious "to remove the uppermost band . . ." and "portions of the outer zig-zag band at the corner portions or any part of the outer zig-zag band which extends above a corresponding adjacent portion of the inner zig-zag band . . ." This convoluted modification of the reference can only be attributed to a hindsight re-engineering of the prior art "Bakery Tray" to re-create the claims in issue. The Carroll design is reproduced below for convenience.



Carroll Figure 1

The Examiner's proposed motivation for the modification is not only unsupported by evidence, but contrary to common sense. The Examiner states that "the inner zig-zag band provides sufficient support to the sides of items stacked in the tray of Carroll and the [modification] would save material cost of resin used in manufacturing and to save weight making transport of the trays more economical." (Examiner's Final Rejection, mailed April 2, 2003, pages 4-5). This motivation fails for several common-sense reasons. Because it is a design patent, we have little information regarding the intended use of the design other than its title: "Bakery Tray or the Like"; however, the Examiner's proposed modification of the Bakery Tray would reduce the height of the sidewalls in some places by about 50% and by about 70% in others. Such a drastic reduction in the height of the sidewalls of the Bakery Tray would significantly reduce the capacity of the tray and its usefulness.

This is an undesirable modification. It must be presumed that such a substantial modification to the design would be undesirable and not obvious.

Additionally, the Examiner's proposed motivation (reduce weight and material) is too vague for his specific modification (eliminate the entire upper band and only specific portions of the outer zig-zag band). There are many portions of the Bakery Tray that could theoretically be eliminated or reduced (if we continue to ignore whether these modifications leave the Bakery Tray functional for its intended purpose). Appellant's claims are the only motivation for eliminating the specific portions chosen by the Examiner, rather than any other portions of the Bakery Tray.

Moreover, referring to Figure 7 of Carroll, eliminating the upper band completely and the outer zig-zag band to the extent it extends above the inner zig-zag band would prevent the trays from stacking neatly and stably one upon the other. The angled lower surface of the outer zig-zag band is intended to rest upon the complementarily angled upper surface of the outer zig-zag band of an identical tray upon which the tray is stacked. The proposed modifications to the Bakery Tray would prevent them from being stacked in a neat and stable manner. Moreover, given the substantial reduction in height of the sidewalls, the baked goods in one tray would be smashed by a second tray stacked on the one tray.

For these reasons, the Examiner's proposed modifications to Carroll would be undesirable and therefore not obvious. At the very least, the Examiner has not established a prima facie case of obviousness without sufficient evidence of motivation for the proposed modification to Carroll.

IV. Obviousness over Apps '925 in view of David

Group I) Claim 8

The Examiner has also rejected claim 8 as obvious over Apps '925 in view of David. The Examiner's proposed modification of the Apps '925 tray to include features purportedly taught by David is inconsistent with the Examiner's application of claim 1 (for example) to Apps '925. Apparently, the Examiner is proposing that David would teach modifying the post 20 of Apps '925 to be v-shaped as shown in David (Figure 6, for example). However, David teaches that the outer ring is still not contoured downwardly to the floor. The outer ring in David is still level, horizontal and vertically spaced from the floor of the crate, not contoured downwardly to the floor. The proposed v-shaped post would be even more clearly

not part of "the band" as claimed and even more clearly not part of a "band contoured downwardly to the floor" as claimed. Therefore, claim 8 is properly allowable.

V. Obviousness over Carroll in view of Apps '925

Group J) Claims 11, 16 and 20

The Examiner has proposed even more drastic modifications to the "Bakery Tray" of Carroll in order to reject claims 11, 16 and 20. After the Examiner's previous modification to Carroll to reject the claims upon which claims 11, 16 and 20 depend, the Examiner called the remaining portions of the outer zig-zag band of Carroll the claimed "columns." Claims 11, 16 and 20 require that the columns each have "an inner column surface which projects inward and an outer column surface which is recessed inward to receive therein the inner column surface of an adjacent below-nested tray." Because the Examiner's previous modification was to remove all of the outer zig-zag band that extends above the inner zig-zag band, the outer zig-zag band can no longer stack on top of the outer zig-zag band of the lower tray. Now, the Examiner apparently needs to add back portions of the outer zig-zag band or some other columns altogether in order to meet the additional terms of claims 11, 16 and 20. It is unclear exactly what this modification would look like, but it certainly looks nothing like James Carroll's Bakery Tray and could only be the result of hindsight with the present claims in hand.

VI. Double-Patenting over U.S. Des. 404,204

Group K) Claims 1-28

Appellant disagrees with the double-patenting rejection over the design patent. "The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. See *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939-40, 220 USPQ 481, 487 (Fed. Cir. 1983) (noting that, while theoretically possible, "[d]ouble patenting is rare in the context of utility versus design patents"); *In re Thorington*, 418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969) (Double patenting between a design and utility patent is possible "if the features producing the novel aesthetic effect of a design patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure."). In these cases, a "two-way" test is applicable. See

Carman, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *Id.*, 220 USPQ at 487. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

The claims of the current application, which can cover multiple embodiments, would not render claim of the Design patent obvious - - or vice versa. Like the claims in *Dembiczak*, the pending claims in this utility patent application do not render the design patent obvious.

The Examiner has not even set forth a prima facie case of obviousness. Since this double-patenting rejection requires two-way obviousness, it is twice as burdensome to expect Appellant to come up with multiple possible obviousness theories, one of which may accurately represent the Examiner's undisclosed prima facie case, and then rebut these hypotheticals one-by-one. However, it is clear that there can be made embodiments covered by the utility claims that are not made obvious by the design claim. Thus, the two-way test is not met.

Although a double-patenting rejection of a utility patent application over a design patent is supposed to be "very rare" (*Dembiczak, supra*), the Examiner appears to be routinely rejecting utility applications over their design patent counterparts simply because the drawings of the design patent illustrate something that would be covered by the utility claims. (For two similar rejections in other applications of Appellant, see Exhibits B & C attached – Exhibit B: Office Action mailed 4/3/03 in commonly assigned application Serial No. 09/785,100, pages 3-4; and Exhibit C: Office Action mailed 5/14/03 in commonly assigned application Serial No. 10/145,226, pages 5-6).

However, this is not the proper test for double-patenting. The proper test for double-patenting requires a comparison of what the two patents cover, whether they are utility patents or design patents. In this case, what must be compared (in a two-way test) are the present utility claims and the claim of the design patent (not the entirety of the drawings).

VII. Double-Patenting over U.S. Pat. No. 6,186,328

Group L) Claims 1-28

The Examiner has rejected all of the pending claims under the judicially-created doctrine of obviousness-type double patenting over related patent U.S. Patent No. 6,186,328. Again, the Examiner has not even set forth a prima facie case of obviousness. Appellant has no indication regarding the Examiner's position on what is different between the prior claims and the present claims, or where the Examiner thinks one of ordinary skill in the art would find motivation to make the claims obvious. If some of the claims were otherwise allowable, Appellant could consider whether the allowable claims warranted a terminal disclaimer, but with all 28 claims rejected and no prima facie case of obviousness established by the Examiner, Appellant is unable to evaluate the rejection or argue against it without comparing all 28 claims against all of the claims in the prior patent. Thus, Appellant requests that the Board reverse the Examiner's rejection or at least remand this issue to the Examiner for further explanation of the rejection if the Board finds at least some of the claims otherwise patentable.

VIII. Rejections under Section 112

The Examiner has rejected claims 13 and 22 as indefinite under Section 112. The Examiner has indicated that Appellant's proposed amendment to claim 22 would be entered, thus mooted the Examiner's rejection of claim 22.

Claim 13 recites "an uppermost edge of the band side detail" and later recites "the upper edge of the band side detail" as shown below (underline added):

13. A low depth nestable tray for containers, having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band is contoured downwardly along the side portions to form a band side detail that directly connects to the floor surface at the side portions of said tray, and wherein an uppermost edge of the band side detail is an uppermost surface of the wall structure at the band side detail and wherein the upper edge of the band side detail at each band side detail is below an uppermost surface of the side and end portions of the band.

The Examiner rejected claim 13:

Claim 13 recites the limitation “the upper edge” of the band side detail in the second to last line. There is insufficient antecedent basis for this limitation in the claim because it can’t be determined if “the upper edge” refers to the “uppermost edge” previously recited in the claim. The claim is ambiguous since the upper edge could refer to any upper edge and upper edge which is not an uppermost edge or an uppermost edge.⁵

Appellant’s earlier Amendment With Appeal sought to amend the “the upper edge” to “the uppermost edge,” in order to remove this issue from the appeal. However, the Examiner refused to enter this amendment saying it “complicates the issues for appeal.”⁶ Although Appellant tried to remove this issue from the appeal with what should have been a straightforward amendment, claim 13 is not indefinite, even without that amendment.

Claim 13 is not indefinite for several reasons. First, even if the Examiner is correct in saying that “the upper edge could refer to any upper edge . . . which is not an uppermost edge or an uppermost edge,” that would only make the claim broader, but not indefinite. This is not a valid ground for declaring the claim indefinite.

Admittedly, the term “the upper edge” does not have explicit antecedent basis in the claim, since “the uppermost edge” was previously recited in the claim. However, the MPEP makes it clear that the lack of explicit antecedent basis for terms does not always render a claim indefinite. All that is required is that “the scope of the claim would be reasonably ascertainable by those skilled in the art . . .”⁷

According to the MPEP:

Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation “the outer surface of said sphere” would not require an antecedent recitation that the sphere has an outer surface. MPEP 2173.05(e).

Similar to a sphere inherently having an outer surface, the “band side detail” would inherently have an “upper edge,” thereby rendering the term “the upper edge”

⁵ Examiner’s Final Rejection, mailed April 2, 2003, page 2.

⁶ Advisory Action, mailed August 19, 2003, page 2.

⁷ MPEP 2173.04(e).

definite. In this context, since the claim refers to "a band," the "the upper edge" is "the uppermost edge."⁸ One of skill in the art would understand that "the upper edge of the band side detail" is referring to the same "uppermost edge" previously recited in the claim, since the element referenced is "a band" and since no other "edge" was recited previously in the claim.

The terms "the uppermost edge" and "the upper edge" were added in the Amendment filed February 6, 2003. In that Amendment, Appellant argued:

[T]he uppermost edge of the band corner portion is an uppermost surface of the wall structure at the corner portion and is below the upper surface of the side and end portions of the band.

This further confirms that "the upper edge" and "the uppermost edge" are the same edge, such that the claim is not indefinite.

CLOSING

For the above reasons, claims 1-28 are patentable.

Appellant has previously submitted the Appeal Brief fee with the Appeal Brief filed November 18, 2002, after which the Examiner reopened prosecution on December 6, 2002 and after which the Examiner mailed the Notification of Noncompliance, so it is believed that no additional Appeal Brief fee is due. Further, no extension of time fee should be necessary due to the PTO being closed on September 18-19, 2003. If any other fees are due, please charge Deposit Account No. 50-1984.

Respectfully submitted,



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Dated: September 22, 2003

⁸ The "upper edge" is of "a band side detail," which in the claim is a portion of a "band."

CLAIMS APPENDIX

1. A low depth nestable tray for containers, said tray having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of said tray, and wherein an uppermost edge of the corresponding band corner portion is an uppermost surface of the wall structure at the corresponding band corner portion and wherein the upper edge of the band corner portion is below uppermost surfaces of the side and end portions.

2. The tray of claim 1, wherein each said band corner portion is formed whereby one said side portion of said band is contoured downwardly and one said end portion is contoured downwardly so as to converge together.

3. The tray of claim 2, further comprising a rib on an exterior surface of each said band corner portion, and a platform formed at a top edge of each said band corner portion to support the rib of an above-nested tray.

4. The tray of claim 1, wherein said band is contoured downwardly at an angle of approximately 50°.

5. The tray of claim 1, wherein said band is also contoured downwardly along the side of said tray to form a band side detail that connects to the floor structure at the side of said tray.

6. A low depth nestable tray of containers, said tray having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged generally perpendicularly to the floor structure along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band includes parallel portions generally parallel to the floor structure and is contoured downwardly along the side portions between the parallel portions to form a band central portion that directly connects to the floor structure at the side portions of said tray.

7. The tray of claim 6, wherein said band central portion has a top edge for contacting and supporting a mating bottom edge of the band central portion of a like tray nested thereabove and wherein the top edge of the band central portion is the uppermost surface of the wall structure at the band central portion.
8. The tray of claim 6, wherein said band is contoured downwardly at an angle of approximately 50° to form said band central portion.
9. The tray of claim 6, wherein the band also contours downwardly to form a band corner portion attached to the floor structure.
10. The tray of claim 9, further comprising a rib formed on an exterior surface of at least one band corner portion, and a platform formed at an upper edge of a corresponding band corner portion for supporting the rib of an adjacent above-nested tray, and wherein an uppermost edge of the corresponding band corner portion is an uppermost surface of the wall structure at the corresponding band corner portion and wherein the upper edge of the band corner portion is below uppermost surfaces of the side and end portions.
11. The tray of claim 6, wherein each column has an inner column surface which projects inward, and an outer column surface which is recessed inward to receive therein the inner column surface of an adjacent below-nested tray.
12. The tray of claim 6, wherein the band has a substantially planar inner surface.

13. A low depth nestable tray for containers, having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band is contoured downwardly along the side portions to form a band side detail that directly connects to the floor surface at the side portions of said tray, and wherein an uppermost edge of the band side detail is an uppermost surface of the wall structure at the band side detail and wherein the upper edge of the band side detail at each band side detail is below an uppermost surface of the side and end portions of the band.

14. The tray of claim 13, wherein one of the side portions of the band is contoured downwardly and one of the end portions of the band is contoured downwardly so as to converge together to define a band corner portion.

15. The tray of claim 14, wherein the band corner portion is integrally attached to the floor structure at each corner of the tray.

16. The tray of claim 13, wherein each column has an inner column surface which projects inward, and an outer column surface which is recessed inward to receive therein the inner column surface of an adjacent below-nested tray.

17. The tray of claim 13, further comprising a rib formed on an exterior surface of at least one band corner portion, and a platform formed at an upper edge of a corresponding band corner portion for supporting the rib of an adjacent above-nested tray.

18. The tray of claim 13, wherein the band side detail is centrally disposed along the length of the side wall.

19. The tray of claim 1, wherein the band has a substantially planar inner surface.
20. The tray of claim 1, wherein each column has an inner column surface which projects inward, and an outer column surface which is recessed inward to receive therein the inner column surface of an adjacent below-nested tray.
21. The tray of claim 13 wherein said band side detail has a top edge for contacting and supporting a mating bottom edge of the band side detail of a like tray nested thereabove.
22. A low depth nestable tray for containers comprising:
a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface;
a low depth wall structure comprising a plurality of columns generally transverse to the floor structure and arranged along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure, the band connected to the floor structure by said columns, and wherein the band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of the tray adjacent the parallel portions, wherein a top surface of the band at the band corner portion is the uppermost surface of the tray at the band corner portion to contact and support a like tray nested thereabove.
23. The tray of claim 22 wherein parallel portions of the band, generally parallel to the floor structure, extend between at least two of the plurality of columns.
24. The tray of claim 22 wherein the top surface of the band is contoured downwardly to form the band corner portion.
25. The tray of claim 22, further comprising a rib on an exterior surface of each band corner portion, the top surface of each band corner portion positioned to contact and support the rib of the above-nested tray.

26. The tray of claim 22 wherein the band includes side parallel portions and end parallel portions generally perpendicular to the side parallel portions, and wherein each band corner portion is between one of the side parallel portions and one of the end parallel portions.

27. The tray of claim 26 wherein an uppermost surface of the wall structure at each of the band corner portions is disposed below the plane of the parallel portions.

28. The tray of claim 27 wherein an uppermost surface of the band is the uppermost surface of the tray at the parallel portions and at the band corner portions.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: William P. Apps

EXAMINER: Castellano, S.

SERIAL NO.: 09/780,073

GROUP ART UNIT: 3727

FILED: February 9, 2001

FOR: NESTABLE CAN TRAY WITH CONTOURED WALL STRUCTURE

ATTY DOCKET NO.: RPC 0557 PUS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SECOND AMENDMENT WITH APPEAL

Dear Sir:

Appellant files this Amendment along with Appellant's Appeal Brief, as provided for in MPEP 1207, in order to remove issues from appeal and avoid a remand by the Board to consider such issues. This amendment is made to correct a minor antecedent basis issue in claim 22. The Examiner has indicated that this Amendment to claim 22 would be entered in his Advisory Action mailed August 8, 2003.

CERTIFICATE OF MAIL

I hereby certify that the enclosed Second Amendment with Appeal is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 22, 2003.



Konstantine J. Diamond

Complete Listing of Claims

1. (Previously Presented) A low depth nestable tray for containers, said tray having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of said tray, and wherein an uppermost edge of the corresponding band corner portion is an uppermost surface of the wall structure at the corresponding band corner portion and wherein the upper edge of the band corner portion is below uppermost surfaces of the side and end portions.

2. (Original) The tray of claim 1, wherein each said band corner portion is formed whereby one said side portion of said band is contoured downwardly and one said end portion is contoured downwardly so as to converge together.

3. (Previously Presented) The tray of claim 2, further comprising a rib on an exterior surface of each said band corner portion, and a platform formed at a top edge of each said band corner portion to support the rib of an above-nested tray.

4. (Previously Presented) The tray of claim 1, wherein said band is contoured downwardly at an angle of approximately 50°.

5. (Previously Presented) The tray of claim 1, wherein said band is also contoured downwardly along the side of said tray to form a band side detail that connects to the floor structure at the side of said tray.

6. (Previously Presented) A low depth nestable tray of containers, said tray having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged generally perpendicularly to the floor structure along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band includes parallel portions generally parallel to the floor structure and is contoured downwardly along the side portions between the parallel portions to form a band central portion that directly connects to the floor structure at the side portions of said tray.

7. (Previously Presented) The tray of claim 6, wherein said band central portion has a top edge for contacting and supporting a mating bottom edge of the band central portion of a like tray nested thereabove and wherein the top edge of the band central portion is the uppermost surface of the wall structure at the band central portion.

8. (Previously Presented) The tray of claim 6, wherein said band is contoured downwardly at an angle of approximately 50° to form said band central portion.

9. (Previously Presented) The tray of claim 6, wherein the band also contours downwardly to form a band corner portion attached to the floor structure.

10. (Previously Presented) The tray of claim 9, further comprising a rib formed on an exterior surface of at least one band corner portion, and a platform formed at an upper edge of a corresponding band corner portion for supporting the rib of an adjacent above-nested tray, and wherein an uppermost edge of the corresponding band corner portion is an uppermost surface of the wall structure at the corresponding band corner portion and wherein the upper edge of the band corner portion is below uppermost surfaces of the side and end portions.

11. (Previously Presented) The tray of claim 6, wherein each column has an inner column surface which projects inward, and an outer column surface which is recessed inward to receive therein the inner column surface of an adjacent below-nested tray.

12. (Previously Presented) The tray of claim 6, wherein the band has a substantially planar inner surface.

13. (Previously Presented) A low depth nestable tray for containers, having a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface, wherein the improvements comprise:

a low depth wall structure comprising a plurality of columns arranged along the periphery of the floor structure, and further comprising a band having side and end portions spaced above the floor structure and connected to the floor structure by said columns to form a unitary construction, wherein said band is contoured downwardly along the side portions to form a band side detail that directly connects to the floor surface at the side portions of said tray, and wherein an uppermost edge of the band side detail is an uppermost surface of the wall structure at the band side detail and wherein the upper edge of the band side detail at each band side detail is below an uppermost surface of the side and end portions of the band.

14. (Previously Presented) The tray of claim 13, wherein one of the side portions of the band is contoured downwardly and one of the end portions of the band is contoured downwardly so as to converge together to define a band corner portion.

15. (Previously Presented) The tray of claim 14, wherein the band corner portion is integrally attached to the floor structure at each corner of the tray.

16. (Previously Presented) The tray of claim 13, wherein each column has an inner column surface which projects inward, and an outer column surface which is recessed inward to receive therein the inner column surface of an adjacent below-nested tray.

17. (Previously Presented) The tray of claim 13, further comprising a rib formed on an exterior surface of at least one band corner portion, and a platform formed at an upper edge of a corresponding band corner portion for supporting the rib of an adjacent above-nested tray.

18. (Previously Presented) The tray of claim 13, wherein the band side detail is centrally disposed along the length of the side wall.

19. (Previously Presented) The tray of claim 1, wherein the band has a substantially planar inner surface.

20. (Previously Presented) The tray of claim 1, wherein each column has an inner column surface which projects inward, and an outer column surface which is recessed inward to receive therein the inner column surface of an adjacent below-nested tray.

21. (Previously Presented) The tray of claim 13 wherein said band side detail has a top edge for contacting and supporting a mating bottom edge of the band side detail of a like tray nested thereabove.

22. (Currently Amended) A low depth nestable tray for containers comprising:

a floor structure with a floor top surface, a floor bottom surface, and a plurality of container support areas on the floor top surface;

a low depth wall structure comprising a plurality of columns generally transverse to the floor structure and arranged along the periphery of the floor structure, and further

comprising a band having side and end portions spaced above the floor structure, the band connected to the floor structure by said columns, and wherein the band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of the tray ~~adjacent the parallel portions~~, wherein a top surface of the band at the band corner portion is the uppermost surface of the tray at the band corner portion to contact and support a like tray nested thereabove.

23. (Previously Presented) The tray of claim 22 wherein parallel portions of the band, generally parallel to the floor structure, extend between at least two of the plurality of columns.

24. (Previously Presented) The tray of claim 22 wherein the top surface of the band is contoured downwardly to form the band corner portion.

25. (Previously Presented) The tray of claim 22, further comprising a rib on an exterior surface of each band corner portion, the top surface of each band corner portion positioned to contact and support the rib of the above-nested tray.

26. (Previously Presented) The tray of claim 22 wherein the band includes side parallel portions and end parallel portions generally perpendicular to the side parallel portions, and wherein each band corner portion is between one of the side parallel portions and one of the end parallel portions.

27. (Previously Presented) The tray of claim 26 wherein an uppermost surface of the wall structure at each of the band corner portions is disposed below the plane of the parallel portions.

28. (Previously Presented) The tray of claim 27 wherein an uppermost surface of the band is the uppermost surface of the tray at the parallel portions and at the band corner portions.

REMARKS

Appellant files this Second Amendment With Appeal along with Appellant's Substitute Appeal Brief, as provided for in MPEP 1207, in order to remove issues from appeal and avoid a remand by the Board to consider such issues. This Amendment is made to correct a minor antecedent basis issue in claim 22 under 35 USC 112. The Examiner has indicated that this Amendment to claim 22 would be entered in his Advisory Action mailed August 19, 2003. If any fees or extensions are due, please charge Deposit Account No. 50-1984.

Respectfully submitted,



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Dated: September 22, 2003

Art Unit: 3727

by Apps et al. ('482).

Apps et al. ('482) discloses a low depth nestable display crate which holds beverage bottles and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.

Claims 28-30, 32-39 are rejected under 35 U.S.C. 102(b) and/or (e) as being anticipated by Koefeldt ('843).

Koefeldt ('843) discloses a low depth nestable display crate which holds one liter beverage bottles (B) in a 3 by 5 array (see Fig. 16-18) and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-51 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5,979,654 to Apps and over drawing figures 1-12 of U.S. Patent No. D400,012 to Apps since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Art Unit: 3727

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A low depth nestable display crate for six-pack bottle carriers comprising a floor, a double thickness wall structure having a lower wall portion, an upper wall portion and a handle bar.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035. The examiner can normally be reached on M-Th 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-31 are rejected under the judicially created doctrine of double patenting over claims 1-22 of U. S. Patent No. 6,386,388 to Overholt, over claims 1-21 of U.S. Patent No. 6,398,054 to Overholt et al. and over Fig. 1-6 of U.S. Design Patent No. D446,392 to Overholt et al. since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A collapsible container arranged to hold an object having a curvature along its length, comprising a base, a first pair of opposed side walls and a second pair of opposed side walls.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 12-31 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 of copending Application No. 10/163,004. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common

subject matter, as follows: A collapsible container arranged to hold an object having a curvature along its length, comprising a base, a first pair of opposed side walls and a second pair of opposed side walls.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant's arguments with respect to claims 12-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.